

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application)	
of U. S. Patent No. 6,342,590)	
)	
Applicants: Shigeo Morimoto et al.)	Group Art Unit:
)	TBA
Granted: January 29, 2002)	
)	
Reissue Serial Number:)	
TBA)	
)	Examiner:
For: Erythromycin A Derivatives and)	TBA
Method for Preparing Same)	

**STATEMENT OF STATUS AND SUPPORT FOR ALL CHANGES TO THE CLAIMS
AND PRELIMINARY AMENDMENT**

Mailstop Reissue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the following amendments be entered before examination of the above-entitled reissue application.

IN THE CLAIMS

Please insert the following new claims:

2. A process for preparing 6-O-methylerythromycin A comprising:

performing the steps of claim 1; then

eliminating in any desired sequence the R¹, R², and R³ groups; and then

deoximating with a deoximating agent.

3. The process of claim 2, wherein the elimination of R¹ is performed by hydrogenolysis.

4. The process of claim 2, wherein the elimination of R² and R³ is performed by treatment with acid in an alcohol.

5. The process of claim 2, wherein the elimination of R² and R³ is performed by treatment with tetrabutyl ammoniumfluoride in tetrahydrofuran.

REMARKS

By the above amendment, claims 1-5 are presented for examination. Support for new claims 2-5 is provided in the specification at, for example, column 4, line 50 through column 5, line 26. No new matter is introduced by this amendment.

Applicants submit that the newly-presented claims are narrower in scope than granted claim 1. Therefore, the claims presented here do not raise issues concerning enlargement of the scope of the claims under 35 U.S.C. § 251, final paragraph.


Applicants are submitting this reissue application because they believe that the original patent, upon which this reissue application was based, is partly inoperative by reason of their claiming less than they had a right to claim therein, in that they had a right to claim their invention more specifically; and more particularly, it was an error not to include claims, such as new claims 2-5, that were narrower in scope than the original and sole patent claim 1. The error of claiming less than they had a right to claim arose without deceptive intent on the applicants' part.

Nevertheless, the learned examiner should be aware that under 35 U.S.C. § 271(g), certain infringements, if performed abroad, might fall within the scope of the newly-added claims, but may be outside of the scope of claim 1. Applicants do not believe that this

possibility affects the status of this reissue application as a "narrowing reissue." First, the newly-added claims are narrower in scope than granted claim 1, since they add more limitations, and that fact satisfies the requirements of § 251. Second, Applicants contend that the intermediate compound produced by the process of claim 1 is not "substantially different" from 6-O-methylerythromycin A produced by the newly-added claims, as that phrase is used in § 271(g). Therefore, Applicants submit that any processes that infringe claims 2 through 5 will also infringe claim 1, even if claim 1 is performed abroad.

In any event, this application is submitted within two years of the January 29, 2002 issue date of the above-named patent, and therefore, Applicants are entitled to enlarge the scope of the patent's current claims by asserting their intention to do so on or prior to January 29, 2004. To the extent the examiner disagrees with the Applicant's legal contention that these newly-presented claims are narrower in scope than claim 1, Applicants hereby assert their intention to enlarge the scope of the claims of the above-mentioned patent. As this application is being filed on or prior to January 29, 2004, Applicant's newly-presented claims comply with 35 U.S.C. § 251 final paragraph.

Dated: January 28, 2004


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